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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,049	09/24/2003	Sanjeev Bedi	PAT 51393A-2	4079
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BORDEN LADNER GERVAIS LLP WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100 OTTAWA, ON K1P 1J9 CANADA			EXAMINER TALBOT, MICHAEL	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

THW

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,049	<b>Applicant(s)</b> BEDI ET AL.	
	<b>Examiner</b> Michael W. Talbot	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/17/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said bit contacting means" in line 16. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, as best understood the limitation has been interpreted as "said locking means".

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,5,7 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Falchle '653. Falchle '653 shows in Figures 1 and 2 a tool holder for a tool bit comprising a body (Fig. 1) having a separate mounting means (2 and col. 2, lines 42-45) for securing a proximal end of body (intersection face of 2 and 1) to a driving tool (1) and a blind axial hole (3) at a distal end thereof for receiving the tool bit with at least a portion of the axial hole having a corresponding cross-section to that of the tool bit (at forward portion, left side of Fig. 1), a locking means (6) engaging at least a portion (5) of the tool bit when tool bit is fully inserted into axial hole, a collar (14) mounted around at least a portion of the body slidable between a locking and unlocking position, a spring (17) mounted between the body and the collar to bias the collar

Art Unit: 3722

towards the locking position, and initial insertion of the tool bit into the axial hole results in contact with the locking means and displacement of collar away from the locking position to allow further insertion until full insertion is reached thus permitting the locking means to engage the tool bit (at 5) and collar to move back to the bit locking position (col. 3, line 49 through col. 4, line 12). Falchle '653 shows the locking means being a transition element, further defined as a locking pin (6), projecting into the axial hole arranged to be contacted by a portion (9) of the tool bit to move the collar towards the locking position as the tool bit becomes fully inserted.

Claims 1,2,4-6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Quiring '946. Quiring '946 shows in Figures 1-2C a tool holder (10) for a tool bit (12) comprising a body (18,20,34) having a mounting means (18) for securing a proximal end of body to a driving tool and a blind axial hole (24) at a distal end (22) thereof for receiving the tool bit with at least a portion of the axial hole having a corresponding cross-section to that of the tool bit (col. 3, lines 53-58), a locking means (40) engaging at least a portion (14) of the tool bit when tool bit is fully inserted into axial hole, a collar (42) mounted around at least a portion of the body slidable between a locking (forward, Fig. 2B) and unlocking (rearward, Fig. 2A) position, a spring (46) mounted between the body and the collar to bias the collar towards the locking position, and initial insertion of the tool bit into the axial hole results in contact with the locking means and displacement of collar away from the locking position to allow further insertion until full insertion is reached thus permitting the locking means to engage the tool bit (at 44) and collar to move back to the bit locking position (col. 5, line 58 through col. 6, line 17). Quiring '946 shows the locking means being a transition element, further defined as a locking ball (40), projecting into the axial hole arranged to be contacted by a portion (bottom) of the tool bit to move the collar towards the locking position as the tool bit becomes fully inserted. Quiring '946

Art Unit: 3722

shows a proximal end of the axial hole (below inclined cam channel 26) having a corresponding cross-section to that of the tool bit (col. 3, lines 53-58).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4207337. DE 4207337 shows in Figures 1-5 a tool holder for a tool bit (3) comprising a body (1,2) having a mounting means (1) for securing a proximal end of body to a driving tool and a blind axial hole (7) at a distal end thereof for receiving the tool bit with at least a portion of the axial hole having a corresponding cross-section to that of the tool bit, a locking means (6) engaging at least a portion (outer surface) of the tool bit when tool bit is fully inserted into axial hole, a collar (4) mounted around at least a portion of the body slidable between a locking (Fig. 3) and unlocking (Fig. 2) position, a spring (5) mounted between the body and the collar to bias the collar towards the locking position, and initial insertion of the tool bit into the axial hole results in contact with the locking means and displacement of collar away from the locking position to allow further insertion until full insertion is reached thus permitting the locking means to engage the tool bit (outer surface) and collar to move back to the bit locking position. DE 4207337 shows the locking means being a transition element, further defined as a locking washer (6), positioned within the axial hole biased by a spring towards a locked position being tilted from a transverse plane to an unlocked position where washer is in the transverse plane.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4-6,15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Wienhold '916. Wienhold '916 shows in Figures 1-5 a tool holder (10) for a tool bit (40) comprising a body (12) having a mounting means (34 and col. 5, lines 5-7) for securing a proximal end (32) of a body to a driving tool and a blind axial hole (36) at a distal end (30)

Art Unit: 3722

thereof for receiving the tool bit with at least a portion of the axial hole having a corresponding cross-section to that of the tool bit (col. 5, lines 8-14 and lines 20-22), a locking means (16) engaging at least a portion (44) of the tool bit when tool bit is fully inserted into axial hole, a collar (14) mounted around at least a portion of the body slidable between a locking (rearward) and unlocking (forward) position, a spring (22) mounted between the body and the collar to bias the collar towards the locking position (col. 6, lines 52-53), and initial insertion of the tool bit into the axial hole results in contact with the locking means and displacement of collar away from the locking position to allow further insertion until full insertion is reached thus permitting the locking means to engage the tool bit (at 44) and collar to move back to the bit locking position. Wienhold '916 shows the locking means being a transition element, further defined as a locking ball (16), projecting into the axial hole arranged to be contacted by a portion (62A) of the tool bit to move the collar towards the locking position as the tool bit becomes fully inserted. Wienhold '916 shows the holder further comprising a spring biased ejection means (26,24) arranged to act on tool bit insertion end (62A) when the collar is moved to the unlocked position whereby the tool bit is ejected from the holder. Wienhold '916 shows a proximal end of the axial hole (adjacent to tool bit insertion end 64A and ejector 24 contact) having a corresponding cross-section to that of the tool bit (col. 5, lines 8-14 and lines 20-22).

Claims 1,2,5,8,9,10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyle et al. '914. Boyle et al. '914 shows in Figures 1-6 a tool holder (12) for a tool bit (14), with a drill bit (50) on one end and a screw driver bit (52) on the opposite end, comprising a body (18,20) having a mounting means (18 and col. 3, lines 21-23) for securing a proximal end of a body to a driving tool and a blind axial hole (22) at a distal end thereof for receiving the tool bit with at least a portion of the axial hole having a corresponding cross-section to that of the tool bit, a locking means (90) engaging at least a portion (46) of the tool bit when tool bit is fully

Art Unit: 3722

inserted into axial hole, a collar (60) mounted around at least a portion of the body slidable between a locking (rearward) and unlocking (forward) position, a spring (61) mounted between the body and the collar to bias the collar towards the locking position (col. 4, lines 64-66), and initial insertion of the tool bit into the axial hole results in contact with the locking means and displacement of collar away from the locking position to allow further insertion until full insertion is reached thus permitting the locking means to engage the tool bit (at 46) and collar to move back to the bit locking position (col. 4, line 61 through col. 5, line 58). Boyle et al. '914 shows the locking means being a transition element, further defined as a detent/rocker arm (90 about spring 106 and groove 108) projecting into the axial hole arranged to be contacted by a portion (116) of the tool bit to move the collar towards the locking position as the tool bit becomes fully inserted.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9,10,12,13,17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wienhold '916 in view of Chen et al. '393. Wienhold '916 lacks the tool holder body being comprised of two parts. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a two part body (10,12 and 40) with the proximal end (10,12) configured to be secured to a driving tool (col. 2, lines 23-25) and a second part (40) secured to the base part having an axial hole (42) for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in

Art Unit: 3722

the art to modify the single piece tool holder body of Wienhold '916 to include a multi-part tool for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part. Moreover it would have been obvious to use a multi-part tool for the single piece tool holder of Wienhold '916 for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Wienhold '916 lacks the tool bit being a double-ended tool bit having a drill bit on one end and a screwdriver bit on the opposite end. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a multipart part body (10,12 and 40) having an axial hole (42,16) to receive a double ended tool (80 and col. 3, lines 2-10) for the purpose of increasing the versatility of the tool holder to receive double-ended tool bits. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in the art to modify the tool holder body of Wienhold '916 to include an axial hole (16) in the proximal end (32) to increase the versatility of the tool holder to receive double-ended tool bits (col. 1, lines 40-44).

6. Claims 9,10,12,13,17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quiring '946 in view of Chen et al. '393. Quiring '946 lacks the tool holder body being comprised of two parts. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a two part body (10,12 and 40) with the proximal end (10,12) configured to be secured to a driving tool (col. 2, lines 23-25) and a second part (40) secured to the base part having an axial hole (42) for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in



Art Unit: 3722

the art to modify the single piece tool holder body of Wienhold '916 to include a multi-part tool for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part. Moreover it would have been obvious to use a multi-part tool for the single piece tool holder of Wienhold '916 for the purpose of increasing the versatility of the tool holder by allowing the use of multiple mounting configurations with different driving means without changing the base holding part because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Quiring '946 lacks the tool bit being a double-ended tool bit having a drill bit on one end and a screwdriver bit on the opposite end. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a multipart part body (10,12 and 40) having an axial hole (42,16) to receive a double ended tool (80 and col. 3, lines 2-10) for the purpose of increasing the versatility of the tool holder to receive double-ended tool bits. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in the art to modify the tool holder body of Wienhold '916 to include an axial hole (16) in the proximal end (32) to increase the versatility of the tool holder to receive double-ended tool bits (col. 1, lines 40-44).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4207337 in view of Chen et al. '393. DE 4207337 lacks the tool bit being a double-ended tool bit having a drill bit on one end and a screwdriver bit on the opposite end. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a multipart part body (10,12 and 40) having an axial hole (42,16) to receive a double ended tool (80 and col. 3, lines 2-10) for the purpose of increasing the versatility of the tool holder to receive double-ended tool bits. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in the art to modify the tool

Art Unit: 3722

holder body of DE 4207337 to include an axial hole (16) in the proximal end (32) to increase the versatility of the tool holder to receive double-ended tool bits (col. 1, lines 40-44).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quiring '946 in view of Falchle '653, further in view of Chen et al. '393. Quiring '946 lacks the locking means being in the shape of a locking pin. Falchle '653 shows in Figures 1 and 2 a locking means (6) being in the shape of a locking pin for the purpose of reducing the wear and deformation between the locking means and the shank of the tool bit (col. 1, lines 30-38). In view of this teaching of Falchle '653, it would have been obvious to one of ordinary skill in the art to modify the tool holder locking means of Quiring '946 to include a pin shaped locking means taught by Falchle '653 for the purpose of reducing the wear and deformation between the locking means and the shank of the tool bit (col. 1, lines 30-38).

Quiring '946 lacks the tool bit being a double-ended tool bit having a drill bit on one end and a screwdriver bit on the opposite end. Chen et al. '393 shows in Figures 1-3,6 and 7 a tool holder having a multipart part body (10,12 and 40) having an axial hole (42,16) to receive a double ended tool (80 and col. 3, lines 2-10) for the purpose of increasing the versatility of the tool holder to receive double-ended tool bits. In view of this teaching of Chen et al. '393, it would have been obvious to one of ordinary skill in the art to modify the tool holder body of Falchle '653 to include an axial hole (16) in the proximal end (32) to increase the versatility of the tool holder to receive double-ended tool bits (col. 1, lines 40-44).

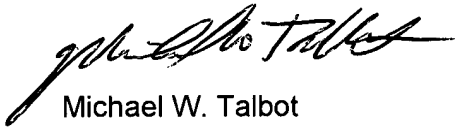
9. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

Art Unit: 3722


In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300.

This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot  
Examiner  
Art Unit 3722  
28 November 2005



ERICA CADOGAN  
PRIMARY EXAMINER